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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,020	09/21/2001	Christopher McDowell	COD-133	7026

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AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,020

Applicant(s)

MCDOWELL, CHRISTOPHER

Examiner

Greg Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment A, presented as Paper No. 9. Claims 1-6, 8-14, and 16 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. The disclosure is objected to because of the following minor informalities: Page 6, line 2, "is frangible connected" is grammatically incorrect.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4, 5, 13, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner questions how the sterility is maintained with openings in the film.

Claim Rejections - 35 USC § 102

5. In light of the applicant's amendment, the rejection of claims 1-4, 6-13, and 15-16 under 35 U.S.C. 102(b) is hereby withdrawn. Claims 7 and 15 were cancelled.

Claim Rejections - 35 USC § 103

6. Claims 1, 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh (US 5,046,611) in view of Asa et al (US 6,098,802).

Regarding claim 1, Oh discloses a tray (10) for holding a plurality of surgical fasteners (20) comprising a base (12, 14, 16) having a plurality of wells (18), at least two of the surgical fasteners (20) disposed within wells (18). Oh meets all limitations claimed by the applicant except for the film and the isolated wells.

Asa et al discloses a tray (12) for sterile articles (P) with a base (16), isolated wells (18), and film (30). Asa et al teaches the wells being isolated to prevent cross-contamination (see for example, Col. 5, ll. 33-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Oh with the film and isolated wells of Asa et al in order to prevent cross-contamination of the fasteners.

As to claim 8, the tray of Oh-Asa meets the method claimed by the applicant by presentation.

As to claim 9, the tray of Oh-Asa discloses penetrating the film with an instrument (Oh, Figure 1 and Asa, Figure 6).

As to claim 16, the tray of Oh-Asa discloses the instrument as an applier for applying the surgical fasteners (Oh, 22a).

7. Claims 2, 3, 6, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh in view of Asa et al as applied to claims 1, 8, and 9 above, and further in view of Jewusiak et al (US 4,294,355).

Regarding claims 2, 10, and 11, the tray of Oh-Asa, as applied to claims 1 and 9 above, discloses the claimed invention except for the weakness in the film.

Jewusiak et al discloses a tray (10) for surgical fasteners (30) having a base (11), wells (channels defined by walls 14, 15, 16, and 17), and film (12). Jewusiak et al further discloses lines of weakness (22, 23) created by scoring or perforating the film (Col. 2, ll. 62-68). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Oh-Asa with lines of weakness as taught by Jewusiak et al in order to reduce the force required to penetrate the film and access the fastener.

As to claims 3 and 12, the tray of Oh-Asa-Jewusiak discloses scoring the film (Jewusiak, Col. 2, ll. 62-68).

As to claim 6, the tray of Oh-Asa-Jewusiak discloses scoring the film (Jewusiak, Col. 2, ll. 62-68) as an ingress means.

Response to Arguments

8. Applicant's arguments with respect to claims 1-6, 8-14, and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner notes that Olsen (US 4,190,153) discloses the openings/slits claimed in claims 4, 5, 13, and 14; however, the applicant has not enabled these particular embodiments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
August 26, 2003


Mickey Yu
Supervisory Patent Examiner
Group 3700